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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,452	07/27/2001	Gerold Tebbe	011104	9150

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EXAMINER

ZIRKER, DANIEL R

ART UNIT PAPER NUMBER

1771

DATE MAILED: 03/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- ☒ Responsive to communication(s) filed on 1/28/03
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- ☒ Claim(s) 1-14 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1, 3, 7-14 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

### Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
  - ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The Examiner notes that 37 CFR 1.71(b) requires the specification to be complete without a reference to extrinsic sources. This is because the claims are dynamic and thus an amendment of the claims leads to a specification that refers to the claims being dynamic and thus never complete. Accordingly, applicant's multiple amendments to the specification which constantly refer to "the claims" are improper and the specification should be so amended to conform to this regulation.

3. The Examiner notes that applicant's clean set of claims does not have the same numbers as the marked up version of the claims. That is, the clean set of claims, which includes claims 1, 3, and 7-14 which are the Official version of the pending claims is believed correct. The amended section, which refers to claims 1, 3, 7, 8, and 14-18 is improper. However, the Examiner will examine the case as if this problem did not exist.

4. Claims 1, 3, and 7-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Speakman or Berner et al., each taken individually, or in view of Tashiro et al. The primary references are again substantially relied upon for their disclosure as was set forth in paragraph Nos. 7 and 9 of the initial Office action Paper No. 8, together with the following additional observations. Applicant now utilizes as his

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independent claim what is in essence a product-by-process claim, in which the microcapsules which contain the powdered paint particles either evaporate or decompose, thus leading to the essential<sup>ly</sup> simple paint laminate structure as disclosed in both Speakman and Berner et al. That is, the claimed product-by-process structure has not been shown on the record to produce a patentably distinct product. Alternatively, if such is not the case, the secondary reference Tashiro et al. discloses that paint containing microcapsules can be utilized using encapsulating pigments to form a product which exhibits a highly attractive paint surface. Accordingly, one of ordinary skill, motivated by the advantages known to exist in paint microcapsule technology which has been admitted by applicant in his response would incorporate the paint containing microcapsules of the secondary reference and after microcapsule disintegration or decomposition either form, or clearly render obvious, the claimed genus of structures. With respect to the dependent claims, these are again handled in the essential manner as previously set forth, in the absence of unexpected results.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Examiner is making the Kondo article entitled "Microcapsule Processing and Technology", which applicant has supplied with his Office action, of record since it was not cited on an accompanying IDS.

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6. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

March 12, 2003

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1980-  
1700

*Daniel Zinker*